

Docket No. 3868-0104P
Appl. No. 09/980,199
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REMARKS

Claims 1-6 are pending in the present application. The Examiner is respectfully requested to reconsider the Restriction Requirement in view of the following Remarks.

The Examiner has required election in the present application between:

Group I, claims 1-4, drawn to a process for manufacturing a product from strip tape; and

Group II, claims 5 and 6, drawn to a device for manufacturing a product from strip tape.

For the purpose of examination of the present application, Applicants elect, with traverse, Group I, claims 1-4.

In order to be responsive to the Examiner's Restriction Requirement, Applicants have elected claims 1-4 for initial examination. However, it is respectfully requested that the Examiner reconsider the Restriction Requirement. The Examiner states "Group II includes the special technical feature of guide means and transport means for transport to a conversion machine in claim 5, which is a special technical feature that Group I does not have." Applicants submit that the Examiner has not applied PCT Rule 13 properly. The test for unity of invention is not whether there are special technical features in one claim that are not included in another claim. The test is whether there is

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a special technical feature that is common to particular claims under consideration. The Examiner is directed to MPEP § 1893.03(d) which states “[a] group of inventions is considered linked to form a single general inventive concept where there is a technical relationship among the inventions that involves at least one common or corresponding special technical feature.” In the present instance, claims 1 and 5 include numerous features that are common to each other. The Examiner has just selected some features that are not common and has considered such features to be the special technical feature. This treatment by the Examiner is improper, since the Examiner has not shown that the features mentioned by the Examiner are the special technical feature and has shown that there are no other features that are special technical features that are common to both claims 1 and 5.

The Examiner is also directed to Example 2 of Annex B Part 2 of the PCT Administrative Instructions, which appears at Appendix A1 of the MPEP. As can be clearly understood, a process of manufacture comprising certain steps has unity with an apparatus designed to carry out certain steps. The Examiner has considered claims 1 and 5 to have no unity, since the apparatus designed to carry out the process steps of claim 1 is recited in the apparatus claim 5.

It should also be noted that there was no lack of unity found in the corresponding PCT Application, where the proper standard for unity of invention was followed. In view

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of this, the Examiner should follow the standard from the corresponding PCT Application.

In addition, as set forth in § 803 of the MPEP, the Examiner must examine an application on the merits if the examination of the entire application can be made without serious burden. Two criteria are identified for proper requirement for restriction:

1. The inventions must be independent or distinct as claimed; and
2. There must be a serious burden on the Examiner if the restriction is not required.

Applicants respectfully submit that a serious burden has not been placed on the Examiner to consider all of the claims in a single application. The Examiner is respectfully requested to consider all of the claims in the present application and to withdraw the restriction requirement.

In order to be responsive to the Examiner's Restriction Requirement, claims 1-4 have been elected with traverse. If the Examiner does persist in this Restriction Requirement, Applicants reserve the right to file a divisional application directed to the non-elected claims at a later date if it is so desired.

Favorable action on the present application is earnestly solicited.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Paul C. Lewis (Reg. No.

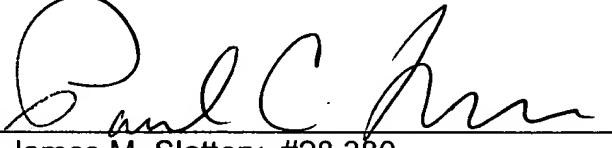
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43,368) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

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